

REMARKS

The above identified patent application has been amended and reconsideration and reexamination are requested.

As the Board entered a new grounds of rejection, Applicant pursuant to 37 CFR § 41.50(b) elects to submit an appropriate amendment of the claims so rejected and have the matter reconsidered by the examiner.

The Board, reversed the Examiner's rejection of claims 1, 3-9, and 16-23, under 35 U.S.C. § 103; and affirmed the Examiner's rejection of claims 10, 12-15, and 24, under 35 U.S.C. § 103.

The Board also under 37 CFR § 41.50(b) entered a new grounds of rejection of Claims 1, 3-9 and 12-13 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Board found "a server process" and "a montage quote manager process" to indicate "software" to be executed on a computer (hardware), but not the hardware upon which the software is executed, thus viewing the recitations as "disembodied server software."

The Board also under 37 CFR § 41.50(b) entered a new grounds of rejection of claims 1, 3-9, 12-13, 16-18, and 24, as anticipated by Korhammer .

Claims 1 and 3-9

The Board stated in part:

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would -not have suggested to one of ordinary skill in the art the invention as set forth in claims 1 and 3-9. Accordingly, we reverse.

The Board however in entering a new rejection, stated:

Claims 1 and 3-9 are rejected under 35 U.S.C. 102 as being unpatentable over Korhammer. We find that Korhammer teaches the following features:

1. Column 2, lines 30-35, teach a plurality of client stations for entering quotes for securities.

As to the "server process" of claim 1, it is disembodied server software, i.e., it is descriptive material in the form of a computer program. Computer programs per se, i.e., the descriptions or expressions of the programs, are not physical things." They are neither computer components nor processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer that permits the computer program's functionality to be realized. As has been discussed above, when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability.

Therefore, we reject claim 1 under 35 U.S.C. 102. Claims 3-9 share the same problem as claim 1. This problem and the related problem in section VI above can both be overcome by amending claims 1 and 6 to read "server means" rather than "server process." This amendment would result in the descriptive material ("computer program" being functionally related to the substrate (server hardware including storage).

Claim 1 has been amended to delete "process" and to recite a server computer. As amended, the recitations in claim 1 are proper under 35 U.S.C. 112, second paragraph. Claim 1 now embodies software executed on a server computer, a hardware device and therefore defines structural and functional interrelationships between the computer program and device that permits the computer program functionality to be realized. Accordingly, the elements of claim 1 are not "non-functional descriptive material," and are therefore entitled to patentable weight and consideration. In view of the Board's holding that Korhammer failed to teach the invention, and recommended amendment of claim 1 to recite "server means" to make the claim allowable, such action is now requested.

The Board entered a new ground of rejection of Claims 12-13 under 35 U.S.C. 112, second paragraph, because at line 1 of each claim is recited "comprising a current quote window" which is redundant to the limitation of "a current quote window" found in claim 10.

Applicants have deleted the redundant limitation.

The Board rejected Claim 18 under 35 U.S.C. 112, second paragraph, because the term "the inside quote" has no antecedent basis in claim 17.

Claim 18 was amended to provide antecedent basis.

Claims 16-18 and 24

The Board entered a new ground of rejection of Claims 16-18 and 24 under 35 U.S.C. 101 as the claimed invention is directed to non-statutory subject matter. The Board reasoned that:

As to claim 16, it preempts the formula for totaling ("aggregating") numerical values (see Appellants figure 9) representing (interest in a product) at a plurality of levels. The fact that the numerical values are labeled as "interest in a product" does not prevent preemption. Nor does the fact that the formula is duplicated as to plural levels.

Claim 16 as amended now calls for receiving, from client systems attributable and non attributable quotes for a product, aggregating the non-attributable quotes in the product to provide a total of all non-attributable interest at a plurality of price levels and sending from the electronic market, data to render a user interface on displays of the client systems, the user interface displaying totals of all interest for a plurality of price levels on the client systems. As such, claim 16, by requiring receiving and displaying, does not "preempt the formula for totaling." Claim 16 now applies aggregating as part of a patentable process, but does not "seek patent protection for that formula in the abstract."

Regarding claim 24, claim 24 now calls for instructions to receive non-attributable interest in the form of quotes and/or orders for a financial product traded in an electronic system and to aggregate non-attributable interest in the financial product to provide a total of all non-attributable interest at a plurality of price levels. Claim 24 also calls for instructions to configure the data corresponding to the total of the non attributable interest ... to render the totals to an output device. Claim 24, by requiring instructions to receive and to configure data for display, does not "preempt the formula for totaling." Claim 24 now applies the instructions to

aggregate the interest, as part of a patentable computer program product residing on a computer readable medium, and accordingly does not "seek patent protection for that formula in the abstract."

Claims 10, 12, 14, and 24

The Board sustained the rejection of Claims 10, 12, 14, and 24 under 35 U.S.C. § 103.

The Board stated:

*** Korhammer teaches a graphical user interface for an electronic market for trading products at figure 5. Korhammer's interface at figure 5 comprises a first window having a first plurality of indicators that displays nonfunctional descriptive material in the scrollable window forming the bottom 90% of the figure. The indicators comprise the 44 sets of four character identifiers, their volume, and their price (analogous to items 265, 266, and 267 in Korhammer's figure 4) in the two columns of the first window. Korhammer's interface at figure 5 also teaches a second window (analogous to item 253 in Korhammer's figure 4), that displays nonfunctional descriptive material, disposed adjacent the first window. That is, Korhammer teaches displaying nonfunctional descriptive material in the form of bid and offer prices (in a first window) and last trade price, etc. (in a second window adjacent the first window). For the sake of argument, we will take the position that Korhammer does not teach nonfunctional descriptive material in the form of "totals of aggregated interest of a second plurality of market participants that exists in the electronic market at each of a third plurality of price levels of a product traded in the market" as recited in claim 10. However, nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004). Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

Accordingly, the Examiner's obviousness rejection of representative claim 10 is sustained based on Korhammer alone.

With respect to claim 10, Appellants argue at page 8 of the brief, "Korhammer does not teach aggregation of quotes for each price level nor is an aggregated value for each price level shown in any of the figures." We do not find this argument persuasive, as claim 10 does not recite the function of aggregating quotes.

As to the feature of showing (displaying) aggregated value (totals), this nonfunctional descriptive material does not distinguish over the prior art as discussed above. Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

Applicant has amended claim 10 to recite non-descriptive functional features that are not shown in the references. Claim 10 now includes an aggregate window, having a first plurality of indicators, each indicator displaying a total of aggregated interest ... each indicator being for one

of a plurality of price levels ... a current quote window disposed adjacent the aggregate window; and with the indicators being controls that when selected by a user allows the user to enter orders to execute against interest represented by the indicator.

Korhammer neither describes nor suggests these features. Accordingly, with the features of "each indicator displaying a total of aggregated interest" being tied to the feature of "controls that when selected by a user allows the user to enter orders to execute against interest represented by the indicator," permits "the descriptive material" to help distinguish over the reference, since the "descriptive material" is recited in a functionally related manner to the substrate of the indicators, thus providing non-descriptive functional features to the claim.

Applicant has added new claims that claim additional features of the now allowable independent claims. These added claims are allowable at least for the reasons discussed in their respective independent claims.

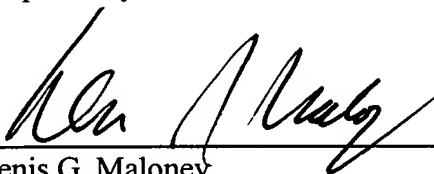
Accordingly, all claims are now in condition for allowance.

Since excess claims fees were already paid no fee is believed due. If a fee is due please apply that fee and any other charges or credits to deposit account 06-1050, reference 09857-027001.

Respectfully submitted,

Date: _____

2/10/06



Denis G. Maloney
Reg. No. 29,670

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906